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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/716,391

11/17/2003

Randolph B. Cohen

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09/05/2008

FOLEY HOAG, LLP
PATENT GROUP, WORLD TRADE CENTER WEST
155 SEAPORT BLVD
BOSTON, MA 02110

EXAMINER

BORLINGHAUS, JASON M

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

09/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/716,391	Applicant(s) COHEN ET AL.	
	Examiner JASON M. BORLINGHAUS	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-58 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

Examiner would like to apologize to the Applicant for the necessity to issue a second restriction requirement for this application. Examiner is aware that this second restriction requirement is different from the first restriction requirement that was issued by the Office on 11/28/2007 and contrary to the telephonic discussion that Examiner had with Applicant, Joshua Coval, previously.

Examiner attempted to contact Applicant, Joshua Coval, via telephone on 08/27/2008 and left voicemail concerning this second restriction requirement. Unfortunately, Examiner has not yet heard back from Applicant.

Applicant is encouraged to contact the Examiner via telephone regarding this restriction requirement, so that it may be discussed and Applicant can elect over the telephone. Telephonic election will allow the Examiner to proceed immediately with a full review of the claimed invention.

Paperwork filed with application indicates that the Applicant(s) are proceeding pro se (i.e. representing themselves), as such Examiner will attempt to explain the legal underpinnings and the rationale behind his arguments.

During the previous telephone conversation, Examiner was led to believe that the various groups of claims were for the same invention and, therefore, all the groups should be reviewed together. Examiner was agreeable to such based upon the Applicant's argument.

However, when Examiner examined the groups of claims, Examiner realized that they were not for the same invention. Examiner believes that Applicant is unfamiliar with what constitutes a single invention. The Applicants' correspondence of 5/23/2008 indicates that all claims relate to "the exact same idea," which Examiner believes reveals the Applicants' unfamiliarity.

The key to restricting between different inventions is not whether they deal with different ideas but whether the claim limitations (i.e. the actual written words of the claims) are different. Leeway is given for claim limitations that are in essence the same but are merely using synonyms or are paraphrasing one another. However, when the claim limitations contain different substantive elements or a different combination of elements, those claims are considered different and, therefore, comprise different inventions.

These substantive differences between groups of claims are termed "patentedly distinct features". These features indicate that each grouping requires a different search and, potentially, the application of different art for rejection. Furthermore, this features mean that each group may, if deemed allowable, its own patent.

Each group below requires different input, and performs different calculations or transformations based upon that input. Applicant believes that each group relates to the same invention but the differences in the written claims do not indicate that such is true. Therefore, the Examiner is issuing a second restriction requirement. This restriction requirement has been discussed with other senior examiners and they felt that my first

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restriction requirement was in error. They feel that the current restriction requirement is the correct restriction between the various claims.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 - 11, 12 – 20 and 21 - 24, drawn to a method and a program, classified in class 705, subclass 36.
- II. Claims 25 – 39 and 50 - 53, drawn to a method, classified in class 705, subclass 36.
- III. Claims 40 – 49 and 54 - 58, drawn to a method, classified in class 705, subclass 36.

The inventions are independent or distinct, each from the other because:

Inventions I - III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable.

In the instant case, subcombination I has separate utility such as quality measuring based upon a financial return of the portfolio and the relative weight of the security in the portfolio. (see Claims 4, 14 and 23).

Subcombination II has separate utility such as quality measuring based upon a financial return of the portfolio and the relative weight of the security in the portfolio, for

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all portfolios that include a sale or purchase of a security, and creation of a first and second sum. (see Claims 28 - 29).

Subcombination III has separate utility such as quality measuring based upon a financial return of the portfolio and the relative weight of the security in the portfolio, for all portfolios that include a sale, purchase or combinations of such between portfolios, and creation of a first, second, third and forth sums. (see Claims 42 - 43).

Subcombination II has separate utility such as quality measuring based upon a financial return of the portfolio and the relative weight of the security in the portfolio, for all portfolios that include a sale or purchase of a security, and creation of a first and second sum. (see Claims 28 - 29).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above

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and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement

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will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON M. BORLINGHAUS whose telephone number is (571)272-6924. The examiner can normally be reached on Monday - Friday; 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on (571)272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason M Borlinghaus/
Examiner, Art Unit 3693

September 1, 2008